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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LY, NGHI H

ART UNIT PAPER NUMBER

2682

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,284

Applicant(s)

CAO ET AL.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-15,17-25,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-15,17-25,27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 3,16 and 26 have been cancelled.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the claim recites "wherein said remote handset can adaptively switch between performing as a telephony device and performing as said MPEG audio player." The specification page 8 line 22-25 of the present invention discloses "Moreover, summation in the digital domain will greatly improve the muting of the MP3 digital audio bit stream as denoted by a figurative switch 202, particularly when a telephone call is in progress." The disclosure does not disclose the remote handset can adaptively switch between performing as a telephony device and performing as said MPEG audio player. Therefore, the above emphasized limitation was not described in the specification at the time the invention was filed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland (US 6,343,217) in view of Rostoker et al (US 6,035,212) and further in view of Rydbeck (WO 99/43136).

Regarding claims 1, 4 and 5, Borland teaches a cordless telephone (see abstract), comprising: a remote handset (see fig.1 handset 110), a base unit matched to said remote handset (see fig.1 handset 120). Borland does not specifically disclose an MPEG audio player integrated within at least one of said remote handset and said base unit. Rostoker teaches an MPEG audio player integrated within the handset (see fig.2

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number 22 and see column 12 lines 42-48) and the base unit (see column 13 line 60 to column 14 line 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rostoker into the system of Borland in order to compress, transmit, receive, and decompress video data without appreciable loss. The combination of Borland and Rostoker does not specifically disclose the remote handset can adaptively switch between performing as a telephony device and performing as audio player.

Rydbeck teaches the remote handset can adaptively switch between performing as a telephony device and performing as audio player (see page 7 lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck into the system of Borland and Rostoker in order provide cellular communications and entertainment during leisure activities (see Rydbeck, page 3 lines 12-13).

Regarding claim 2, the combination of Boland, Rostoker and Rydbeck further teaches the cordless telephone according to claim 1, wherein: said MPEG audio player is integrated within said remote handset (see Rostoker fig.2 number 22 and see column 12 lines 42-48, also see column 13 line 60 to column 14 line 4).

6. Claims 6, 7, 11, 13-15, 17, 18, 21, 23-25, 27, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland (US 6,343,217) in view of Rostoker et al (US 6,035,212) and further in view of Razavi et al (US 6,253,122).

Regarding claims 6, 7, 17, 18 and 27, Borland teaches a cordless phone (see abstract). Borland does not specifically disclose apparatus for integrating an MPEG audio player in a telephone. Rostoker teaches integrating an MPEG audio player in a cordless telephone. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rostoker into the system of Borland in order to compress, transmit, receive, and decompress video data without appreciable loss. The combination of Borland and Rostoker does not specifically disclose playing pre-loaded MP3 music. Razavi teaches playing pre-loaded MP3 music (see column 15 lines 13-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Razavi into the system of Borland and Rostoker so that the user can enjoy listening to music for entertainment.

Regarding claims 11 and 21, the combination of Borland, Rostoker and Razavi further teaches the method of integrating an MPEG audio player in a cordless telephone further comprising: downloading digital bit stream music comprised in an MPEG format to said remote handset directly from a remote bit stream audio source (see Rostoker fig.6 digital signal processor: boxes DSP 210 and DSP 212).

Regarding claims 13 and 23, the combination of Borland, Rostoker and Razavi further teaches the method of integrating an MPEG audio player in a cordless telephone comprising: storing said downloaded digital bit stream music comprised in an MPEG format in said remote handset of said cordless telephone (see Rostoker fig.6 boxes 208, 212 and 224).

Regarding claims 14 and 24, the combination of Borland, Rostoker and Razavi further teaches the method of integrating an MPEG audio player in a cordless telephone wherein: the downloaded digital bit, stream music comprised in an MPEG format is stored in Flash memory in said remote handset (see Rostoker column 9 lines 29-31).

Regarding claims 15 and 25, the combination of Borland, Rostoker and Razavi further teaches the method of integrating an MPEG audio player wherein: the remote bit stream audio source is accessible by said remote handset via an Internet (see Rostoker column 13 lines 20-24).

Regarding claim 28, the combination of Borland, Rostoker and Razavi further teaches the apparatus for integrating an MPEG audio player in a cordless telephone, further comprising: means for decompressing MPEG formatted music into digital music samples for digital to analog output (see Rostoker column 10 lines 45-52).

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borland (US 6,343,217) in view of Rostoker et al (US 6,035,212) and further in view of Razavi et al (US 6,253,122) and Sitnik (US 6,300,880).

Regarding claim 8, the combination of Borland, Rostoker and Razavi teaches the method of integrating an MPEG audio player in a cordless telephone play MP3 music. The combination of Borland, Rostoker and Razavi does not specifically disclose the music is played substantially real-time as it is received by the cordless telephone. Sitnik teaches the music is played substantially real-time as it is received by the cordless telephone (see column 11 lines 25-29). Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to provide the teaching of Sitnik into the system of Borland, Rostoker and Razavi in order to provide a simple and inexpensive receiver (see column 11 lines 25-29).

8. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland (US 6,343,217) in view of Rostoker et al (US 6,035,212) and further in view of Razavi et al (US 6,253,122) and Wingate (US 6,006,115).

Regarding claims 9, 10, 19 and 20, the combination of Borland, Rostoker and Razavi teaches the method of integrating an MPEG audio player in a cordless telephone. The combination does not specifically disclose muting the playing of said pre-loaded MP3 music when said remote handset is active in a current telephone call. Wingate teaches muting the playing of said pre-loaded MP3 music when said remote handset is active in a current telephone call (see column 4 lines 29-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Wingate into the system of Borland, Rostoker and Razavi so that the user won't miss the telephone call while enjoy listening to music.

9. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland (US 6,343,217) in view of Rostoker et al (US 6,035,212) and further in view of Razavi et al (US 6,253,122) and Bartlett (US 5,519,762).

Regarding claims 12 and 22, the combination of Borland, Rostoker and Razavi teaches the method of integrating an MPEG audio player in a cordless telephone and

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downloading digital bit stream music comprised in an MPEG format in a base unit of the cordless telephone. The combination of Borland, Rostoker and Razavi does not specifically disclose storing the bit stream in a base unit of the cordless telephone. Bartlett teaches storing the bit stream in a base unit of the cordless telephone (see column 10 lines 1-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Bartlett into the system of Borland, Rostoker and Razavi in order to compress, transmit, receive, and decompress video data without appreciable loss.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 2, 4-15, 17-25, 27 and 28 have been considered but are moot in view of the new ground(s) of rejection.

On page 3 of applicant's remarks, applicant argues that "Rostoker's data compression is utilized for video NOT audio.

The examiner, however, disagrees. Rostoker does indeed teach data compression is utilized for audio (column 13 lines 5-12 see "audio").

Regarding claims 1,2,4-15,17-25,27 and 28 of applicant's remarks (pages 3-8), applicant argues that "Rostoker fails to teach an MPEG audio player integrated within at least one of a remote handset and a base unit" and "Neither Borland, Rostoker or Razavi, either alone or in combination, disclose, teach or suggest an MPEG audio

player integrated within at least one of a remote handset and a base unit” and “or playing MPEG music from a remote handset”.

The examiner, however, disagrees. The claim 1 recites “within at least one of a remote handset and a base unit.” Therefore, to the examiner, the term “at least one” means at least one in two. Furthermore, Rostoker does indeed teach an MPEG audio player integrated within a remote handset (see Rostoker fig.6 box 218 MPEG2, and see column 13 lines 5-13) and playing MPEG music from a remote handset (Rostoker inherently teaches playing MPEG music from a remote handset since in column 1 lines 33-48, Rostoker discloses the word “information” is used to encompass digital music and “information” is sent and received over airways so that user can play and enjoy music). In addition, applicant’s attention is directed to the rejection of claim 1 above.

Regarding claims 6-15,17-25,27 and 28 of applicant’s remarks (pages 5-8), applicant further argues that “Neither Borland, Rostoker, Razavi, Sitnik, Wingate nor Bartlett, either alone or in combination, disclose, teach or suggest playing MP3 music from a remote handset.”

The examiner, however, disagrees. Razavi teaches playing MP3 music (see Razavi column 15 lines 13-15) and Borland teaches the handset (see Borland fig.1 remote handset 110). The combination does indeed teach playing MP3 music from a remote handset as claimed.

Regarding claims 1 and 2 of applicant’s remarks (page 4), applicant further argues that “it could not be obvious to add any type of data compression to Borland's system which teaches to operate without data compression.”

The examiner, however, disagrees. Since data compression has advantages such as more data can be transmitted over a given bandwidth, it is obvious to provide the data compression to Borland in order to obtain the above advantage.

Regarding claims 6,7,11,13-15,17,18,21,23-25,27 and 28 of applicant's remarks (page 5), applicant argues that "Razavi teaches a vehicle system NOT a telephony system.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Razavi teaches playing pre-loaded MP3 music (see Razavi column 15 lines 13-15) and Borland teaches the telephony system (see Borland fig.1). The combination of Razavi and Borland does indeed teach playing pre-loaded MP3 music from a remote handset as claimed.

Regarding claims 4-11,13-15,17,18-21,23-25,27 and 28 of applicant's remarks (pages 4, 6, 7 and 8), applicant argues that "The Applicants respectfully suggest that the need to combine as many as three (3) or four (4) separate patents to allegedly arrive at the presently claimed invention is evidence of the non-obviousness of the present invention.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection

does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Regarding claim 8 of applicant's remarks (page 6), applicant argues that "Sitnik's headphones are NOT a remote handset."

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Sitnik teaches music is played substantially real-time as it is received by the cordless telephone (see Sitnik column 11 lines 25-29) and Borland teaches the remote handset (see Borland fig.1 remote handset 110). The combination of Sitnik and Borland does indeed teach applicant's claimed limitation.

Regarding claims 9,10,19 and 20 of applicant's remarks (page 7), applicant argues that "Wingate's playing music from headphones is NOT playing music from a remote handset."

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Wingate teaches muting the playing music while in active in a current telephone call (see Wingate column 4 lines 29-39) and Borland teaches the

remote handset (see Borland fig.1 remote handset 110). The combination of Wintage and Borland does indeed teach applicant's claimed limitation.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone numbers

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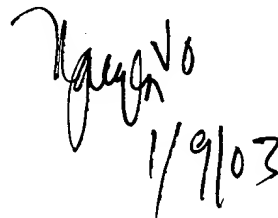
for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Nghi H. Ly



January 9, 2003



NGUYEN T. VO
PRIMARY EXAMINER